

### REMARKS

Claims 1 - 10, 17 - 23, 27 - 29, 32 - 34, and 37 - 48 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable.

Claims 1 - 10, 17, 27, 34, and 46 - 48 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Publ. Appln. No. 2001/0029353 to Peterson in view of U.S. Patent No. 6,869,395 to Page et al. (hereinafter "Page"). (See 6/6/11 Office Action, p. 2).

Claim 1 recites, *inter alia*, "...a wedge disposable within the lumen of the first hollow member for slidable movement therethrough between positions including a first position in which the wedge is disposed entirely within the lumen of the first hollow member *and is spaced from the second hollow member* and a second position in which the wedge is disposed entirely within the lumen of the first hollow member and contacts the first hollow member and second hollow member to wedge the members together to inhibit relative axial movement of the two members." (Emphasis added).

The Examiner again acknowledges that Peterson fails to disclose a wedge disposable in a hollow member for slidable movement between a first position in which the wedge is disposed entirely within the lumen of the first hollow member spaced from the second hollow member and a second position in which the wedge is disposed entirely within the lumen of the first hollow member contacting the first hollow member to inhibit axial movement of the first and second members relative to one another. The Examiner maintains that Peterson cures the deficiencies of Page. However, it is respectfully maintained that Page fails to disclose a wedge as recited in claim 1.

Page relates to a mechanism for attaching accessory devices to the distal end of an endoscope or catheter. (See Page, Abstract). According to one embodiment, the attachment

mechanism 880 comprises a separate wedge element 882 independently loadable onto the distal end 18 of the endoscope. (See Id., col. 12, lines 17 - 22). The wedge element 882 of Page is independently attached to the distal end 18 of endoscope. Page goes on to state that the attachment mechanism 880 also comprises a circumferential ramp cone 884 attached to the accessory 704 that is engageable over the cylindrical wedge 882. (See Id.).

The Examiner asserts that the first position of claim 1 is analogous to the wedge of Page not placed in a location that will cause a locking engagement between the members, thereby allowing free movement of the second member. (See 6/6/11 Office Action, p. 4). The Examiner also maintains that since the wedge element 882 is "independently loadable" onto the distal end 18 of the endoscope, the wedge element 882 is "capable of a plurality of positions." (See 6/6/11 Office Action, p. 3).

It was previously argued that the wedge of claim 1, particularly the first position that the wedge is configured to be disposed, is not disclosed in Page. In its entirety, Page includes no showing or suggestion of a wedge disposed entirely within the lumen of the first hollow member and "spaced from the second hollow member." As noted above, the wedge element 882 of Page is loaded onto the endoscope. While the loading of the wedge on the endoscopic is "independent," there is no reference whatsoever that suggests that the wedge element is ever in a position spaced from the end of the endoscope or that the wedge is slidable within the lumen between the first and second positions. In contrast to the Examiner's contention, the wedge element 882 of Page must be loaded onto the distal end 18 of the endoscope for the wedge 882 to engage the circumferential ramp 884. (See Page, col. 12, lines 17 - 22; and Fig. 20A and 20B). It is not possible for the wedge element 882 to function as described if the wedge 882 is not loaded onto the distal end 18 of the endoscope prior to placing the endoscope within the ramp cone 884.

In response to the above argument, the Examiner appears to only address the "second position" of claim 1. (See 6/6/11 Office Action, p. 11). Specifically, the Examiner provides an

explanation of how the second position is disclosed when the wedge of Page is in a locking position. However, it is respectfully submitted that the locking position of the wedge in Page purportedly disclosing the second position of claim 1 is irrelevant to the discussion related to the wedge of Page being configured to be disposed in the first position as recited in claim 1.

It is respectfully submitted that no matter which point the wedge of Page is seen between the two members, at no time is the wedge ever disposed in a first position in which the wedge is "disposed entirely within the lumen of the first hollow member" and "spaced from the second hollow member," as recited in claim 1. As discussed above, the wedge of Page is loaded onto the distal end of the endoscope. Therefore, at this time, the wedge is disposed on a periphery. That is, the wedge is not disposed entirely within the lumen of the endoscope. Because the wedge is on an exterior of the endoscope, the wedge cannot be configured for a slidable movement "within the lumen of the first hollow member" or endoscope 20. In its entirety, Page only discloses the embodiment in which the wedge is attached to an exterior of the distal end 18 of the endoscope 20, not an interior of the circumferential ramp cone 884 of the accessory 704.

In addition, the wedge is configured for "slidable movement [through the lumen of the first hollow member] between positions including a first position...and a second position," as recited in claim 1. In view of the above discussion and even assuming the disposition within a lumen is disclosed in Page (which is clearly not the case), the separation between the endoscope and the accessory does not allow for the wedge to be "slidable" between the first and second positions. Once the ramp cone 884 of the accessory 704 is received over the sloped outside surface 888 of the wedge element 882, the endoscope and the accessory may be slid relative to each other to achieve the locking position. (See Page, col. 12, ll. 37 - 41). However, only these two components are allowed for a sliding movement. In its entirety, there is no disclosure in Page that the wedge element 882 is slid.

Thus, it is respectfully submitted that Peterson and Page, taken alone or in combination, fails to teach or suggest "a wedge disposable within the lumen of the first hollow member *for*

*slidable movement therethrough* between positions including a first position in which the wedge is disposed entirely within the lumen of the first hollow member and is spaced from the second hollow member and a second position,” as recited in claim 1. Accordingly, it is respectfully submitted that the rejection of claim 1 should be withdrawn for at least the reasons provided above. As claims 2 - 10, 17, 27, 34, and 46 - 48 depend from and include all of the limitations of claim 1, it is respectfully submitted that the rejection of these claims should also be withdrawn.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as obvious over Peterson in view of Page in further view of U.S. Patent No. 4,498,902 to Ash et al. (hereinafter “Ash”). (See 6/6/11 Office Action, p. 5). It is respectfully submitted that Ash fails to cure the above-described deficiencies of Peterson and Page. As claim 18 depends from and includes all of the limitations of claim 1, it is respectfully submitted that the rejection of claim 18 should also be withdrawn for the reasons stated above with reference to claim 1.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as obvious over Peterson in view of Page in further view of U.S. Patent No. 6,875,219 to Arramon et al. (hereinafter “Arramon”). (See 6/6/11 Office Action, p. 6). It is respectfully submitted that Arramon fails to cure the above-described deficiencies of Peterson and Page. As claims 20 and 21 depend from and include all of the limitations of claim 1, it is respectfully submitted that the rejection of these claims should also be withdrawn for the reasons stated above with reference to claim 1.

Claims 19, 22, 23 and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over Peterson in view of Page in further view of PCT Publ. Appln. No. WO 98/36785 to Stouder. (See 6/6/11 Office Action, p. 6). It is respectfully submitted that Stouder fails to cure the above-described deficiencies of Peterson and Page. As claims 19, 22, 23 and 28 depend from and therefore include all of the limitations of claim 1, it is respectfully submitted that the rejection of these claims should also be withdrawn for the reasons stated above with reference to claim 1.

Claims 29, 32, 33, 37 - 41, 44, and 45 stand rejected under 35 U.S.C. § 103(a) as obvious over Peterson in view of U.S. Patent No. 5,695,475 to Best, Jr. et al. (hereinafter "Best") in further view of Stouder. (See 6/6/11 Office Action, p. 7). Peterson was discussed above.

Claim 29 recites, *inter alia*, "...a second hollow member in adjustable communication with the first hollow member for extending the unobstructed passageway provided in part by the first hollow member to a predetermined internal location *beyond a distal end of the first hollow member...*" (Emphasis added):

It was previously submitted that it would not be possible to modify the teachings of either Peterson or Best as suggested by the Examiner. The Examiner maintains the modification and provides reasons that purportedly provide the motivation for the combination. (See 6/6/11 Office Action, p. 12). However, it is respectfully submitted that the previously presented arguments do not relate to a lack of teaching, suggestion, or motivation. In contrast, it is respectfully maintained that the device of Peterson and Best cannot be modified as suggested by the Examiner since one skilled in the art would not have a reasonable expectation of success. Specifically, "the prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success." (See MPEP 2143.02, citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). In this case, it is respectfully submitted that there is no degree of predictability for the purported modification to allow one skilled in the art to conclude a reasonable expectation of success. That is, the asserted modification is not possible without a fundamental change in the respective functionalities as taught in the references. Therefore, in view of the discussion below, it is maintained that the Examiner's assertion for the modification is misplaced.

Peterson relates to a tool for use in internal surgical procedures, such as laparoscopic surgical procedures. (See Peterson, Abstract). The tool 100 includes a main body 120 having a hollow center channel and an outer adjustment sleeve 116. (See *Id.*, p. 2, ¶ [0027]). According to Peterson, the "outer adjustment sleeve 116 adapted to provide a depth-settable scope *at the*

*bottom of the tool 100.*" (See Id.). (Emphasis added). Furthermore, Peterson states that "*the outer adjustment sleeve 116 is inserted within the pressurized body cavity...*" (See Id., p. 3, ¶ [0034]). (Emphasis added). In other words, the adjustment sleeve 116 resides at the bottom of the tool 100 and this outer sleeve 116 is the portion of the tool inserted in the body cavity. Thus, the adjustment sleeve is the distal-most portion of the Peterson tool 100. It is also important to note, that as depicted in each of the figures of the Peterson references, the elongated section 112b of the main body 112 is shorter than the outer adjustment sleeve 116. (See Id., Figs. 1A, 1C, and 1E). Thus, it would not be possible for the elongated section 112b to extend beyond a distal end of the adjustment sleeve 116. Specifically, the distal end of the upper portion 112a will prevent the elongated section 112b from extending past the distal end of the adjustment sleeve 116. (See Id.). In contrast to the Examiner's contention, it would not be feasible to allow the elongated section 112b to extend distally beyond the sleeve 116.

Best, Jr. relates to a syringe apparatus 10 including an outer cylindrical sleeve 12 and a smaller diameter inner sleeve 13 slidably positioned within. (See Best, col. 3, lines 5 - 8). The outer sleeve 12 includes a C-shaped slot 18 which allows a penetrable member 19 of the inner sleeve 13 to lock in place. (See Id., col. 3, lines 17 - 30). This slot 18 allows for the inner sleeve 13 and its needle 15 to be fully retracted within the outer sleeve 12. (See Id., col. 3, lines 45 - 50). However, as depicted in Figs. 1 - 9, this slot 18 also prevents the inner sleeve 13 from extending beyond the distal end of the outer sleeve 12. (See Id., Figs. 1 - 9). Specifically, the foot 25 of the slot 18 prevents the inner sleeve 12 from advancing beyond the position depicted in Fig. 1. In addition, both the egress 37 and the coiled spring 17 (positioned between the egress 37 and the needle 17) would also prevent the inner sleeve 13 from advancing beyond a distal end of the outer sleeve 12. It should also be pointed out that the diameters for the distal ends of the various outer sleeves are narrower than the diameter of the inner sleeve. (See Id.). Thus, it would not be feasible to allow the inner sleeve 13 to extend beyond a distal end of the outer sleeve 12.

Accordingly, the purported modification to either Peterson or Best to allow for a second

hollow member to extend to a location beyond a distal end of a first hollow member is misplaced. Specifically, one skilled in the art would not have a reasonable expectation of success from the combination thereof. Accordingly, it is respectfully requested that the rejection of claim 29 be withdrawn for at least the reasons provided above. As claims 32, 33, 37 - 41, 44, and 45 depend from and therefore include all of the limitations of claim 29, it is respectfully submitted that the rejection of these claims should also be withdrawn.

Claims 42 and 43 stand rejected under 35 U.S.C. § 103(a) as obvious over Peterson in view of Best and Stouder in further view of Arramon. (See 6/6/11 Office Action, p. 10). It is respectfully submitted that Arramon fails to cure the above-described deficiencies of Peterson, Best, and Stouder. As claims 42 and 43 depend from and therefore include all of the limitations of claim 29, it is respectfully submitted that the rejection of these claims should also be withdrawn for the reasons stated above with reference to claim 29.

Applicant respectfully submits that all of the pending claims are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date:

8/1/11

By:

Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP

150 Broadway, Suite 702

New York, New York 10038

Tel: (212) 619-6000

Fax: (212) 619-0276/212-208-6819